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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	)	
	)	ATTORNEY FILE NO.:
Inventors: Jiaping Song	)	SLA1167
	)	
Serial No.: 10/092,199	)	
	)	Examiner: Qin, Yixing
	)	
Filed: March 4, 2002	)	Customer No.: 55,286
	)	
Title: SYSTEM AND METHOD FOR	)	Group Art: 2622
PRINTING A CAMERA IMAGE)	)	
WITH TIME STAMP	)	Confirmation No.: 8581
	)	

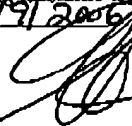
## CERTIFICATION UNDER 37 CFR § 1.8

I hereby certify that this correspondence is being facsimile transmitted to the US Patent and Trademark Office, fax No. 571 273 8300, on this date 8/9/2006

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Board of Patent Appeals and Interferences  
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REPLY TO EXAMINER'S ANSWER

This paper is a Reply Brief responsive to an Examiner's Answer mailed on August 1, 2006, in the rejection by Examiner Yixing Qin, Group Art Unit 2622, of claims 1, 3-11, and 13-18, all claims in the above-referenced application.

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### STATUS OF THE CLAIMS

Claims 1, 3-11, and 13-18 are in the application.

Claims 1, 3-11, and 13-18 are rejected.

Claims 1, 3-11, and 13-18 are appealed.

### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 4 and 10 are indefinite under 35 U.S.C. 112, second paragraph.
2. Whether claims 1, 3-7, 10-11, and 13-16 are unpatentable under 35 U.S.C. 103(a) with respect to Kakigi et al. ("Kakigi"; US 2002/0054350), in view of Shiota et al. ("Shiota"; US Patent 6,185,000).
3. Whether claims 8-9 and 17-18 are unpatentable under 35 U.S.C. 103(a) with respect to Kakigi, Shiota, and further in view of Kobori et al. ("Kobori"; US Patent 5,028,993).

### ARGUMENT

1. *The rejection of claims 4 and 10 under 35 U.S.C. 112, second paragraph.*

The Examiner's Answer states that claims 4 and 10 have been rejected under 35 U.S.C. 112, second paragraph, because there is insufficient antecedent basis for the phrase "the print time stamp option". The Applicant assumes that the Examiner has objected to the use of the article "the" in the above-referenced phrase.

In response, the Applicant notes that this rejection is being made for the first time in the Examiner's Answer. That is, the Examiner's

Answer fails to identify this rejection as a new rejection under 37 CFR 41.39. As noted in MPEP 1207.03, new grounds for rejection are generally a rare occurrence. In this particular instance, the phrase "the print time stamp option" appears in the original presentation of the claims, and the Applicant respectfully submits that this rejection is being made unreasonably late in the prosecution process. However, the rejection can be traversed on the merits as follows.

The use of the article "the" in the phrase "the print time stamp option" does not render the claim indefinite. The second paragraph of 35 U.S.C. 112 states that "(t)he patent specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter of the invention." An expert in the art reading the claim would understand that claim 4 (and 10) introduce an additional limitation to the method (system) – the presentation of the option, which permits a user to select a print time stamp. An expert reading claim 4, which is the combination of claims 1, 3, and 4, would understand that the limitation of *selecting* the print time stamp option is being initially introduced in claim 4.

Whether a claim is indefinite "depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed.Cir.1986).

Further, the Applicant's phrase is clearer than if the article "a" has been recited, in that the Applicant's version recites that the user has the binary option of either engaging, or not engaging the process of converting image and time stamp information into bitmap information. That is, the phrase "selecting a print time stamp option" would be more

confusing, in that it suggests that a user may choose between multiple print time stamp options. Note, "print stamp *layout*" options may be selected (see claim 6), however, these auxiliary options are only chosen after the initial binary decision of "selecting the print stamp option".

The person claiming invalidity under the second paragraph of section 112 must show by clear and convincing evidence that the claims at issue are indefinite. *Morton Intern, Inc. v. Cardinal Chem. Co.*, 5 F.3<sup>rd</sup> 1464, 1470 (Fed. Cir.1993). The Applicant respectfully submits that that Examiner has failed to produce any evidence to support the supposition that claims 4 and 10 are actually indefinite.

**2. The rejection of claims 1, 3-7, 10-11, and 13-16 under 35 U.S.C. 103(a) as unpatentable with respect to Kakigi et al. ("Kakigi"; US 2002/0054350), in view of Shiota et al. ("Shiota"; US Patent 6,185,000).**

Section I of the Final Office Action states that claims 1, 3-7, 10-11, and 13-16 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Kakigi in view of Shiota. With respect to claims 1 and 10, the Office Action acknowledges that "(a)lthough Kakigi does not explicitly disclose that the date (i.e., time stamp) is embedded in the image after editing. It would be inherent that this is so, since the Kakigi reference discloses the date information as part of the inherent image information in item 23 of Fig. 5."

Section 1 of the *Response to Arguments* Section of the Examiner's Answer states that Kakigi converts an image into bitmap data, and "the date would inherently be converted since it is part of the inherent information in the image. Since the data information is

inherently part of the image, the date information is inherently embedded with the converted bitmap image.”

In response, the Applicant first notes that Kakigi proves no evidence to assume that his attribute information (e.g., time stamp) is “inherently” part of the image. In fact, Kakigi clearly presents evidence to the contrary. Kakigi describes element 20 (Fig. 5) as an “image forming instruction file”, which includes the subcomponents of image common information 21 [0189-0191], which may include information such as model name and date when the image was stored [0511]. The “inherent information” subcomponent 22 includes information such as product ID and format of the image file 10 [0512]. Thus, Kakigi clearly describe an image file 10 and a separate “imaging forming instruction file 20. The two distinct files are shown in Fig. 4 as independent files depending from a common root [0187-0188]. Since Kakigi explicitly states that the attribute information is separate from the image file, the attribute information cannot be “inherently part of the image”, as suggested in the Examiner’s Answer. Therefore, the Examiner’s statement that “the date information is inherently embedded with the converted bitmap image” is logically flawed.

*In re Robertson* 169 F.3d 743, 49 USPQ2d, 1949, 1950 (Fed. Cir. 1999) restates the principle that to establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference...” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991). In this case, the Examiner has failed to provide extrinsic evidence to show that the attribute information is necessarily embedded with the image file.

Section 2 of *Response to Arguments* initially rephrases the Applicant's argument that neither Shiota nor Kakigi describe a printer able to embed time stamp information in an image bitmap. The *Response to Arguments* Section then states that the third limitation of Applicant's claim 1 recites "displaying the images with corresponding time-stamps for editing...", but asserts that the claim never states that the printer or control panel is used for editing images.

First, the Applicant notes that claim 1 recites a method for "using a printer to interpret time stamp information from a digital camera", with the steps of:

"at the printer from panel, displaying the images with corresponding time stamps for editing", and,

"in response to the editing, embedding time stamp bitmap information in the image bitmap information".

The Applicant respectfully submits that the only possible interpretation of this claim is that the editing is performed at the printer. This is especially true if the claim is interpreted in light of the specification and drawings, which is the current position of the CAFC (see, *Phillips v. AWH Corp.*). Support for the claim can be found in the specification at page 4, ln. 18 through page 7, ln. 8 (Fig. 1), and page 8, ln. 17 through page 10, ln. 11 (Fig. 3).

Second, the *Response to Arguments* Section acknowledges that the meaning of the claim is understood.

In summary, Kakigi does not describe a process that embeds a time stamp bitmap into an image bitmap. A fuller rationale to support this assertion can be found in the Applicant's Appeal Brief. Shiota also

fails to describe a process that embeds one bitmap inside of another bitmap. Since Kakigi provide no means for sophisticated image data manipulation on a printer, the combination of Shiota with Kakigi merely reinforces the conventional perception that a computer-based print driver would be needed to perform the functions recited in the Applicant's claims 1 and 10.

With respect to claim 11, Kakigi can only generate bitmap data from a print job or from camera images. Kakigi discloses absolutely no means of converting "attribute information", such as date, into bitmap information. Even when combined with Shiota, Kakigi discloses no means of embedding one bitmap into another bitmap. Both the prior art references suggest that image modifications must be performed with a print driver on a PC, prior to being sent to the printer.

Claims 1, 10, 11 describe image processing being performed by a printer in response to prompts at the printer's front panel. As mentioned earlier, Shiota is the only reference that performs any type of image/print stamp manipulation, but this processing is done prior to being sent to the printer. Further, claims 1, 10, and 11 describe a process of embedding time stamp bitmap information into the image bitmap information. Neither Shiota nor Kakigi describe a printer that is able to embed time stamp bitmap information in an image bitmap. Claims 3-7, dependent from claim 1, claims 13-16, dependent from claim 11, enjoy the same distinctions from the cited prior art.

***3. The rejection of claims 8-9 and 17-18 under 35 U.S.C. 103(a) as unpatentable with respect to Kakigi, Shiota, and further in view of Kobori et al. ("Kobori"; US Patent 5,028,993).***

Section 3 of the *Response to Arguments* Section of the Examiner's Answer states that the Kobori reference was introduced to show that the superposition of text over images is a process known in the art. The *Response to Arguments* Section acknowledges that "(t)he intent was not to specifically combine the processing technique of Kobori, but rather take to idea and implement it in the Kakigi/Shiota inventions."

In response, the Applicant notes that to prove a case for obviousness, a *prima facie* case must be made by the Examiner that there some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Applicant respectfully that no proof has been proved that the abstraction of an idea from a field of art using analog NTSC video format signals suggests any modifications to the field of art using digital image and printer language formats.

In summary, the Office Action states that it would have been obvious to improve Kakigi's invention with Shiota's and Kobori's editing capabilities to allow users more flexibility in customizing images. This statement does not provide any analysis of how Kobori suggests any kind of modification to Kakigi. Rather, it is an example of a retrospective analysis that presents laudatory goals as a motive for combining references, on the basis of a search using elements from the Applicant's claims as keywords.

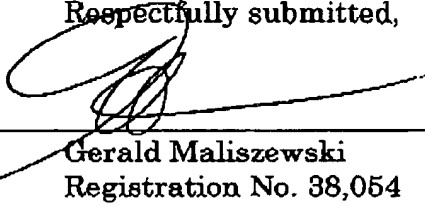
Neither Shiota nor Kakigi describe the conversion of time stamp information into bitmap information, or the embedding of bitmap information. Kobori describes no process for converting time stamp data



into bitmap data, or the conversion of overlaid analog video signals into a single bitmap file. So, the combination of Shiota, Kakigi, and Kobori also fails to teach this limitation recited in claims 1 and 11. Claims 7-8, dependent from claim 1, and claims 17-18, dependent from claim 11, all enjoy the same distinctions from the cited prior art.

Respectfully submitted,

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